REMARKS/ARGUMENTS

Reconsideration and reexamination of the present application are hereby requested. Applicant respectfully points out although the Office Action Summary indicates that the Office action is a non-final action, page 7 indicates that the action is final. During a telephone conference with the Examiner, the Examiner indicated that the Office action is a non-final action, and Applicant responds to the Office action accordingly.

Claims 1-9 and 11-28 are now in the application.

The Examiner has rejected Claims 1, 11, 13, 15-17, 22 and 25 under 35 U.S.C. §102(b) as being anticipated by Wahl et al. (U.S. Patent No. 6,228,086). Additionally, the Examiner rejected Claim 21 under 35 U.S.C. 103(a) as being unpatentable over Wahl in view of Stauch et al. (U.S. Pat. No. 6,416,516).

The Applicant's amended Claim 1 calls for (underlining added for emphasis):

"A bone fixing system comprising a nail, the nail comprising . . . three transverse bores, and three screws, which can be guided through the transverse bores formed in the nail . . .

wherein the spatial orientation and position imposed on a screw guided through one of the transverse bores is different <u>in three dimensions</u> for each of three transverse bores . . ."

Claim 25 includes substantially similar language as the Claim 1 language above. As such, the Applicant submits that Claims 1 and 25 are not anticipated by Wahl under 35 U.S.C. §102(b).

Wahl is directed to modular intramedullary nail. Specifically, Wahl teaches a nail 1 having a bore serving to receive an insert 7. Additionally, the nail includes a slot 8 which extends parallel to the nail's longitudinal axis,. The insert insertable into the nail includes two guiding bores 29 which are inclined with respect to the longitudinal axis.

While Wahl may teach an insert for a nail, the insert including guiding bores, Wahl does not describe, teach or suggest a <u>nail</u> comprising <u>three transverse bores</u>. Rather, the insert is used to provide additional bores needed to accommodate all of the screws. Additionally, when the insert is housed within the nail, the guiding bores in the insert must be aligned with the slot on

the nail. Thus, the spatial orientation and position of any element inserted into the guiding bores is restricted to two dimensions. Accordingly, Wahl does not describe, teach or suggest that the spatial orientation and position imposed on a screw guided through one of the transverse bores is different in three dimensions for each of the transverse bores.

Accordingly, the Applicant submits that Claim 1 is not anticipated by Wahl under 35 U.S.C. §102(b).

Claims 11-17, 21 and 22 are dependent on Claim 1. As such, these claims are believed allowable based upon Claim 1.

The Examiner has rejected Claims 1, 11-17 and 25 under 35 U.S.C. §103(a) as being unpatentable over Freeland (4,862,833).

As noted above, the Applicant's amended Claim 1 calls for (underlining added for emphasis): "wherein the spatial orientation and position imposed on a screw guided through one of the transverse bores is different in three dimensions for each of three transverse bores . . ." Also as noted above, Claim 25 contains substantially similar language.

Applicant's amended Claim 1 additionally calls for (underlining added for emphasis) "at least one clamping member which can be introduced into the longitudinal bore . . . with all screws guided through the transverse bores being able to be clamped between a clamping member and the inner wall of the nail bounding the transverse bore by a displacement of at least one clamping member."

The Applicant submits that the invention as claimed in Claim 1 is neither taught, described or suggested in Freeland.

Freeland is directed to an interlocking intramedullary nail having a pair of axially aligned screw apertures 55, 56 established in opposite inner and outer sides of a rod R. A single screw S is adapted to extend through the bone marrow in a chamber 18 through the screw apertures. As conceded by the Examiner, Freeland does not disclose a nail including three transverse bores nor three screws. The Examiner argues that "mere duplication of the essential working parts of a device involves only routine skill in the art, citing *St. Regis Paper Co. v. Bemis Co.*, 193

U.S.P.Q. 8 (7th Cir. 1977) (holding that the addition of multiple layers to a bag when the use of multiple layers in bags was known in the bag industry was obvious over the prior art).

Applicant points out that the addition of multiple bores and screws as claimed in the present invention is not merely duplication of the essential working parts of a device. The multiple bores must be configured to define an orientation and a position of a screw with respect to the longitudinal axis of the nail that is different in three dimensions for each of the transverse bores, allowing the nail to be secured along multiple axes. Merely having a single bore configured to define a specific orientation and position of a single screw does not suggest having multiple bores adapted to receive multiple screws, nor does it suggest configuring the bores to orient and position multiple screws differently in three dimensions.

Additionally, Freeland does not suggest at least one clamping member accommodating the three screws which are oriented differently in three dimensions. Rather, Freeland teaches that when the shaft 60 of the tool T is in its lower, set position, the passage 63 in the shaft registers with the apertures 55, 56 in the rod and the anchor screw to effectively lock the shaft within the rod. As such, one function of the anchor screw is to lock the shaft, in addition to anchoring the intramedullary nail within a bone. Accordingly, since clamping of the single anchor screw is not addressed by Freeland, Freeland does not suggest clamping of all screws between a clamping member and the inner wall of the nail.

Accordingly, the Applicant submits that it would not have been obvious to one having ordinary skill in the art to construct the assembly of Freeland having a plurality of transverses bores and screws imposable at different spatial orientations and positions in three dimensions. Therefore, Claims 1 and 25 are patentable over Freeland.

Claims 11-17 are dependent on Claim 1. As such, these claims are believed allowable based upon Claim 1.

Therefore, in view of the above amendment and remarks it is submitted that the claims are patentably distinct over the prior art and that all the rejections to the claims have been overcome. As such, allowance of the above Application is requested.

Respectfully submitted,
CHRISTIE, PARKER & HALE, LLP

By _____
Thomas J. Daly
Reg. No. 32,213
626/795-9900

OSB/cks

JMP PAS726021.1-*-03/22/07 12:51 PM